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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,103	01/17/2002	Takeshi Miyakawa	217829USOPCT	2093
22850	7590	02/15/2005		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER RAYFORD, SANDRA M	
			ART UNIT	PAPER NUMBER
			1772	
DATE MAILED: 02/15/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/030,103	Applicant(s) MIYAKAWA ET AL.	
	Examiner Sandra M. Nolan	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims

1. Claims 2-12 are pending.

Request for Sequentially Numbered Claims

2. It is requested that applicants renumber certain claims of this application so that all of the claims are numbered sequentially. Specifically, claims 2 and 3, which depend on claim 8, would be better placed if they had higher numbers than claim 8.

Comment re: Copending Application having a Common Inventor

3. The examiner notes that application, SN. 10/505,447, filed on 14 January 2005 by Minuro Oda, is not currently available in the Office's eDAN/IFW database. Its claims could not be reviewed prior to this office action.

Rejections Withdrawn

4. The provisional obviousness-type double patenting rejection of claims 2, 8 and 9 for being unpatentable over claims 8 and 10 of copending application SN.10/343,308 in view of Bird et al (US 5,857,572) is withdrawn in order to apply a new rejection.
5. The provisional obviousness-type double patenting rejection of claims 3-7 and 10-12 for being unpatentable over claims 8 and 10 of SN.10/343,308 in view of Bird and Kitaoka (JP 11147569A) is withdrawn in order to apply a new rejection.

New Rejections

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 2-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8 and 10 of copending Application No. 10/343,308 in view of Bird and Kitaoka.

This is a provisional obviousness-type double patenting rejection.

The '308 application, Bird and Kitaoka, and their applicability in combination, are discussed in sections 10 and 11 of the 30 September 2004 office action ("the last office action").

Contrary to applicants' assertion on page 5 of their 29 November 2004 response ("the last response"), the Bird reference, which is entitled "Component Carrier Tape", discloses blends of polyethylene terephthalate and polycarbonates at col. 6, lines 14-22.

Also, applicants' silence regarding the examiner's characterization of the claims of the '308 application deemed to be acceptance of the accuracy of same.

8. Claims 2-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-18 of copending Application No. 10/296,937 in view of Bird and applicants' admission at page 1, lines 8-13 of the specification.

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This is a provisional obviousness-type double patenting rejection.

Claim 18 of the '937 application covers sheets for packaging electronic components, which sheets are multilayer, have surface resistivities of 10^2 to $10^{12} \Omega$, and have antistatic agents on their surfaces.

The '937 application claim does not recite blends of polyester and polycarbonate resins or polycarbonate surface layers.

Bird is discussed in the last office action. Note that, at col. 6, lines 8-13, it teaches that its polymer blends lend toughness and flexibility to carrier tapes.

It is well known that carrier tapes include sheets and are used to package electronics.

In the specification, at page 1, lines 8-13, applicants state that polycarbonate resins are conventionally used in carrier tapes.

The citations are analogous because both deal with sheets for packaging electronics.

It would have been obvious to one having ordinary skill in the art at the time of the invention to employ the resin blends of Bird and the polycarbonates of the specification in the sheets of the '937 application in order to improve the toughness and flexibility of the '937 sheets.

The motivation to employ the resin blends of Bird in the sheets of the '937 application is found at col. 6, lines 8-13 of Bird, where it teaches that its polymer blends lend toughness and flexibility to carrier tapes.

The motivation to employ the polycarbonates of the specification in the sheets of the '937 application is found in the passage discussed, where it teaches that polycarbonates are conventionally used in carrier tapes.

It is deemed desirable to make carrier tapes using sheets that are tough and flexible and have polycarbonate layers thereon in order to facilitate the packaging of electronics therewith.

9. Claims 2-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 23 and 24 of copending Application No. 10/635,501 in view of Kitaoka.

This is a provisional obviousness-type double patenting rejection.

The '501 application claims cover sheets comprising a polycarbonate surface layer (claim 22, last two lines) and a substrate layer containing 1 to 50% polycarbonate resin (claim 24, line 2) along with polyethylene terephthalate (claim 23, line 5).

It fails to claim an antistatic coating.

Kitaoka is discussed in the last office action. Note that it states that its antistatic coatings provide an antistatic effect (see the Abstract, "Problem to be Solved").

It would have been obvious to one having ordinary skill in the art at the time of the invention to employ the antistatic coating of Kitaoka on the sheets of the '501 application in order to provide an antistatic effect.

The motivation to employ the antistatic coating of Kitaoka on the sheets of the '501 application is found in the Abstract, "Problem to be Solved" section of Kitaoka, where it teaches that its antistatic coatings provide an antistatic effect.

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It is deemed desirable to make carrier tapes that have antistatic effects in order to lessen the likelihood that static will affect the packaged electronics and/or their packaging.

Response to Arguments


Applicant's arguments with respect to claims 2-12 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication should be addressed to Sandra M. Nolan-Rayford, at telephone number 571/272-1495. She can be reached Monday through Thursday, from 6:30 am to 4:00 pm, ET.

If attempts to reach the examiner are unsuccessful, contact her supervisor, Harold Pyon, at 571/272-1498.

The fax number for patent application documents is 703/872-9306.


S. M. Nolan-Rayford
Primary Examiner
Technology Center 1700

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